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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/659,632
Filing Date: September 10, 2003
Appellant(s): LIGHT ET AL.

Mark V. Muller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 03/31/2008 appealing from the Office action mailed on 02/05/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0043758	Sorvari et al.	03/2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-46 are presented for examination.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> or
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-46 are rejected under 35 U.S.C. § 102(e) as being anticipated by Sorvari et al. (Sorvari) Pub. No. 2004/0043758.

4. As to claim 1, Sorvari teaches the invention as claimed, including a method, comprising: receiving computing platform service information associated with at least one service offered by at least a subset of a plurality of service points (pages 4-5, paragraph [0059, 0061, 0067]);

storing at least a portion of the computing platform service information (page 4, paragraph [0059]); and

periodically transmitting, without confirmation, a part of the at least a portion of the computing platform service information to at least one potential subscriber to the at least one service (page 4, paragraph [0059] , page 10, paragraph [0123], pages 23-24, paragraphs [0307 - 0309]).

5. As to claims 2-4, Sorvari inherently teaches determining that the at least one service offered by one of the plurality of service points is no longer available; wherein determining that the at least one service offered by one of the plurality of service points is no longer available further comprises: determining that the at least one service does

not respond to a polling query, or determining that the at least one service does not respond within a selected timeout period (pages 25-26 , paragraphs [0337-0341]).

6. As to claims 5-7, Sorvari teaches discovering that a new service offered by one of the plurality of service points is currently available, providing a direction to the new service; discovering that a new service offered by an additional service point not included in the plurality of service points is currently available (page 23, paragraphs [0298 - 0302]).

7. As to claim 8, Sorvari teaches the at least one service includes a wireless service selected from: a network connection service, a printer service, a display service, a storage service, an inventory service, a game service, an interactive customer service, a query service, a communication service, and an advertising service (page 4, paragraph [0059]; page 10, paragraph [0123]).

8. As to claims 9-14, Sorvari teaches periodically transmitting occurs at a single physical location; the plurality of service points are located in a range area; monitoring the range area to detect a plurality of broadcasting service points; monitoring the range area to detect at least one wireless service broker; receiving computing platform service information associated with at least one service offered by at least a subset of a plurality of service points located in another range area from a single wireless service broker; receiving computing platform service information associated with at least one service

offered by at least a subset of a plurality of service points from at least one wireless service broker (page 10 , paragraph [0123]).

9. As to claims 15-16, Sorvari teaches the computing platform service information includes an extensible markup language device description; the part of the at least a portion of the computing platform service information includes sufficient information to access the service directly (page 6, paragraphs [0073 - 0074]; page 11, paragraph [0157]).

10. As to claims 17-20, Sorvari teaches the service is offered by a Universal Plug and Play (UPnP) node; the computing platform service information comprises unsolicited computing platform service information; the computing platform service information comprises at least one attribute associated with the at least one service; the at least one attribute is selected from at least one of a range, a signal strength, and a location (pages 6-7, paragraph [0082 - 0083]; page 10, paragraph [0123]).

11. The following is a quotation of 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 21-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim “An article comprising a tangible computer-readable medium containing computer-executable

instructions which, when executed, results in a machine performing" raises a question as to whether the subject matter is new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement. Examiner suggests applicant replaces with "An article comprising a tangible computer-readable storage medium containing computer-executable instructions which, when executed, results in a machine performing" to overcome the 35 U.S.C. 101 rejection.

13. Claims 21-46 have similar limitations as claims 1-20; therefore, they are rejected under the same rationale.

(10) Response to Arguments

(I) Applicant's arguments related to the objection to the specification. Applicant argues that appellant declines to amend the specification to include a summary of the invention because appellant is unaware of any legal requirement.

As to point (I), Examiner notes that MPEP does not explicitly require applicant to provide a summary of the invention. Examiner believes applicant should support high quality publication of US patents using the guidelines illustrate the preferred layout for the specification of a utility application by providing a BRIEF SUMMARY OF THE INVENTION in the specification. However, if applicant insists not providing a BRIEF SUMMARY OF THE INVENTION. Examiner withdraws the request.

(II) Applicant's arguments related to limitations in claim 1. Applicant argues that prior art does not teach periodically transmitting, without confirmation, a part of the at least a portion of the computing platform service information to at least one potential subscriber to the at least one service.

As to point (II), Sorvari teaches a server automatically transmits local recommendation to a wireless device without confirmation from the wireless device. It is true that Sorvari's wireless device periodically transmits current context in an updated menu request message as pointed out by applicant. However, **the wireless device does not respond or send any acknowledgement back to the server in response to the transmission of the local recommendation from the server** (page 4, paragraph [0059] , page 10, paragraph [0123], pages 23-24, paragraphs [0307 – 0309]).

(III) Applicant's arguments related to limitations in claims 21-28. Applicant argues that appellant has already amended claim 21 to recite "An article comprising a tangible computer-readable storage medium containing computer-executable instructions which, when executed, results in a machine performing." to overcome 35 U.S.C. §101 rejection.

As to point (III), **Examiner disagrees, applicant does not amend claim 21 as stated. Applicant does not amend claim 21 to recite "An article comprising a tangible computer-readable storage medium".** Therefore, the rejections of claims 21-28 under 35 U.S.C. § 101 is being maintained. Copy of claim 21 from applicant's claims appendix is reproduced below for reference.

21. An article comprising a tangible computer-readable medium containing computer-executable instructions which, when executed, results in a machine performing:

receiving computing platform service information associated with at least one service offered by at least a subset of a plurality of service points in a range area;

storing at least a portion of the computing platform service information; and

periodically transmitting, without confirmation, a part of the at least a portion of the computing platform service information to at least one potential subscriber to the at least one service.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Le Luu/

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